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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/801,872 | 03/15/2004 | William H. Meek | 8285/672 | 4492 |

7590 07/28/2005
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

TIEU, BENNY QUOC

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2642

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/801,872 | Applicant(s) MEEK ET AL. | |
| | Examiner Benny Q. Tieu | Art Unit 2642 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (U.S. Patent No. 5,537,464).

Regarding claim 1, Lewis et al. teach a database for a telecommunication service comprising: a storage medium (Fig. 1A, 190); a first record for a first NXX number stored by the storage medium, the first record providing a directive that a call to the first NXX number not having an associated automatic number identification is not to be completed (column 7, lines 51-54).

Regarding claim 2, Lewis et al. further teach the database comprising: a second record for a second NXX number stored by the storage medium, the second record providing a directive that a call to the second NXX number not having an associated automatic number identification and an associated calling party identification is not to be completed (column 8, lines 14-27).

Regarding claim 3, Lewis et al. further teach the database comprising: a third record for a third NXX number stored by the storage medium, the third record providing a directive that a

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call to the third NXX number having neither an associated automatic number identification nor an associated calling party identification is not to be completed (column 8, lines 14-27).

Regarding claim 4, Lewis et al. further teach the database wherein the first NXX number is a 555 NXX number (column 7, lines 20-25).

Regarding claim 5, Lewis et al. teach a method of providing a telecommunication service comprising the steps of: receiving a query associated with a first NXX call to a first number not having an associated automatic number identification (Fig. 2A, 109); and inhibiting completion of the first NXX call to the first number because the first number does not receive calls that do not have an associated automatic number identification (Fig. 2B, 251).

Regarding claim 6, Lewis et al. further teach the method comprising the steps of: receiving a query associated with a second NXX call to the first number, the second NXX call including an associated automatic number identification (Fig. 2A, 109); and completing the second NXX call to the first number (column 8, lines 1-5).

Regarding claim 7, Lewis et al. further teach the method wherein the step of completing the second NXX call includes sending a response message to a service switching point (Fig. 1A).

Regarding claim 8, the limitations of the claim are rejected for the same reasons as set forth in the rejection of claims 5 and 6 above.

Regarding claim 9, Lewis et al. further teach the method wherein at least one of the steps of inhibiting completion of the first NXX call and inhibiting completion of the third NXX call includes sending the call to a terminating announcement (Fig. 1A, 145).

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Regarding claim 10, Lewis et al. further teach the method wherein the steps are ordered steps (Figs. 2A & 2B).

Regarding claim 11, Lewis et al. further teach the method wherein at least one of the steps of completing the second NXX call and completing the fourth NXX call includes sending a response message to a service switching point (Fig. 1A).

Regarding claim 13, Lewis et al. further teach the method wherein the first NXX call is a 555 NXX call (column 7, lines 20-25).

Regarding claim 14, Lewis et al. further teach the method wherein the step of inhibiting completion of the first NXX call includes sending the call to a terminating announcement (Fig. 1A, 145).

Regarding claims 15 and 17-20, the limitations of the claims are rejected for the same reasons as set forth in the rejection of claims 1-11, 13 and 14 above.

Regarding claims 12 and 16, Lewis et al. further teach that the call without ANI would be routed to an operator to obtain addition information and may be completed (Fig. 2B, 217-225).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,148,070. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent '070 claim the method, system, and database for providing a telecommunication service. Claims 1 and 12 of instant application correspond to claim 1 of patent '070; claim 4 of instant application corresponds to claim 3 of patent '070; claims 5, 6 and 8 of instant application correspond to claim 4 of patent '070; claim 12 of instant application corresponds to claim 5 of patent '070; claim 13 of instant application corresponds to claim 6 of patent '070; claim 10 of instant application corresponds to claim 7 of patent '070; claim 9 of instant application corresponds to claim 8 of patent '070; claim 11 of instant application corresponds to claim 9 of patent '070; claim 15 of instant application corresponds to claim 10 of patent '070; claim 16 of instant application corresponds to claim 11 of patent '070; claim 17 of

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instant application corresponds to claim 12 of patent '070; claim 18 of instant application corresponds to claim 13 of patent '070; claim 19 of instant application corresponds to claim 14 of patent '070; and claim 20 of instant application corresponds to claim 16 of patent '070. The common subject matter is whether or not to complete a call with or without ANI and/or calling party identification associated therewith to a predetermined NXX number.

5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,516,057. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant application and patent '057 claim the method, system, and database for providing a telecommunication service. Claims 5, 6, and 8 of instant application correspond to claim 1 of patent '057; claim 12 of instant application corresponds to claim 2 of patent '057; claim 9 of instant application corresponds to claim 3 of patent '057; and claim 11 of instant application corresponds to claim 4 of patent '057. The common subject matter is whether or not to complete a call with or without ANI and/or calling party identification associated therewith to a predetermined NXX number.

Conclusion

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

OR Hand-delivered responses should be brought to:

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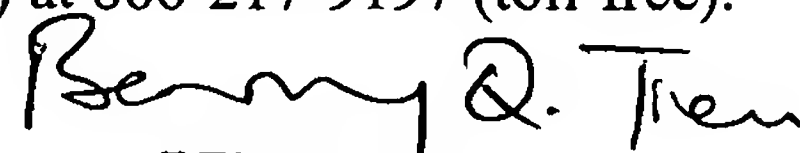
401 Dulany Street,

Alexandria, VA 22314

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benny Q. Tieu whose telephone number is (571) 272-7490. The examiner can normally be reached on Monday-Friday: 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BENNY TIEU
PRIMARY EXAMINER

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July 23, 2005